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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/715,478	11/17/2000	Beth Anne Allison	2196/1E500	7552

7590

04/19/2002

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EXAMINER

HUI, SAN MING R

ART UNIT	PAPER NUMBER
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1617

DATE MAILED: 04/19/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/715,478

Applicant(s)

ALLISON ET AL.

Examiner

San-ming Hui

Art Unit

1617

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 01 March 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See attachment.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: None.Claim(s) objected to: None.Claim(s) rejected: 1-10.Claim(s) withdrawn from consideration: None.

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

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Advisory Action

Continuation of 5):

Applicant's remarks filed March 1, 2002 regarding the photodynamic compounds recited in claim 6 being enabled have been considered but are not found persuasive as discussed in the rejection under 35 USC 112, first paragraph set forth in the previous office action mailed December 18, 2001, the compounds disclosed in the specification page 30, line 5- page 31, line 15 and the compounds disclosed in page 17, line 18-page 35, line 15 in the specification have been noted to be considered enabled by the examiner previously (See page 2 of the office action mailed December 18, 2001).

Therefore, the porphyrin derivative compounds disclosed in the specification are considered enabled. However, the term "porphyrin derivatives" which is recited in claim 6 reads on all porphyrin derivative compounds, including a range of compounds not disclosed in the specification. One of ordinary skill in the art would not know how to use any other derivative compounds for the purpose of the invention without undue experimentation. Therefore, porphyrins compounds other than the porphyrin compounds disclosed in the specification, are considered not enabled.

Applicant's remarks filed March 1, 2002 that a skilled person would be able to administer any photosensitizer in a method encompassed by the claims and determine the appropriate conditions for the claimed invention because, as the applicant further asserts, "the Examiner has recognized that optimization of conditions is routine in the art" have been considered but are not found persuasive because as discussed in the rejections under 35 USC 103 set forth in the previous office action mailed December 18,

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2001, the optimization of result effective parameters such as dosage range and dosage regimens for BPD-MA is within the purview of the skilled artisan in view of the cited prior art which teaches BPD-MA is administered in a substantially similar manner. Applicant asserts that the process of selecting appropriate compounds to practice the claimed invention is optimization. Contrary to the applicant's assertion, it is not seen to be the optimization because undue experimentation would need to be conducted to identify the suitable compounds. Once the suitable compound is identified, it is obvious to optimized the result effective parameters such as the length of irradiation and the energy level of radiation.

Applicant's remarks filed March 1, 2002 regarding the claimed method including the use of low dose irradiation have been considered but are not found persuasive to remove the rejections under 35 USC 112, second paragraph because the method steps herein are taught by Adili et al. This reference also uses a low dose irradiation of $100\text{J}/\text{cm}^2$ (See the abstract) and yet the result taught in Adili et al. is a complete depletion of SMC after the treatment. Please note that a low dose irradiation is defines as $0.5 - 200\text{ J}/\text{cm}^2$ according the instant specification page 14, line 19-28. It is unclear how the results of the instant claimed method of incomplete depletion of SMC would be achieved without any differences in the active method steps than the method of Adili et al.

Applicant's remarks regarding the rejection under 35 USC 103 have been considered. Examiner believed the remarks had been adequately addressed in the Final rejection mailed December 18, 2001.

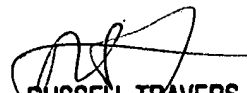
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to San-ming Hui whose telephone number is (703) 305-1002. The examiner can normally be reached on Mon 9:00 to 1:00, Tu - Fri from 9:00 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Minna Moezie, J.D., can be reached on (703) 308-4612. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4556 for regular communications and (703) 308-4556 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

San-ming Hui
April 17, 2002


RUSSELL TRAVERS
PRIMARY EXAMINER
GROUP 1200